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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/617,340

07/17/2000

Joseph Gross

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05/22/2003

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EXAMINER

HAYES, MICHAEL J

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 05/22/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,340

Applicant(s)

GROSS ET AL.

Examiner

Michael J Hayes

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29 and 31-82 is/are pending in the application.
- 4a) Of the above claim(s) 40-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29,31,32,34-37 and 39 is/are rejected.
- 7) ☒ Claim(s) 33 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims Withdrawn Remain in the Application

Claims 29, 31-82 are pending. In Paper No. 12, received 5/9/03, Applicant stated that claims 40-82 were previously canceled, but there is no record of such cancellation in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 29, 34, 35, 36, and 37 are rejected under 35 U.S.C. 102(a) as being anticipated by GALLI (WO 94/11041). Galli discloses a syringe comprising a barrel, needle, energization source 22, actuator, spring retractor 36, 412 biasing the sleeve, and nozzle sleeve moveably mounted at the first end of the barrel from a first position with needle concealed to second position with needle exposed, to a third activation position where said energization source is activated to move a piston to drive liquid from the reservoir through the needle. (pg 11, lines 9-21, pg. 17, lines 9-36; Figs. 13, 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over GALLI as applied to claim 29 above, and further in view of MERCADO et al. (U. S. Patent No. 5,540,665. Galli discloses the claimed invention except for the use of a citric acid/bicarbonate soda gas generator to provide the force to drive a piston to expel medication from the syringe. Mercado teaches the use of a solid solution of citric acid and sodium bicarbonate in separate compartments that combine to generate gas for propelling medication out of the syringe (6:43-7:19). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Mercado in the syringe of Galli in order to provide controllable and variable force for driving medication out of a syringe. Re claim 39 the use of needle covers for safety reasons is notoriously well known in the art.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over GALLI. Galli shows the claimed invention in Figs. 1, 2, 4-6, 13, and 14, but does not show a needle cover in these figures. Galli does show a needle cover 413 in the embodiment of Fig. 12A. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the needle cover of Fig. 12a in the other embodiments disclosed in order to prevent inadvertent needle sticks.

Allowable Subject Matter

Claims 33 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

Applicant argues that Galli does not show a sleeve mounted at the first end of the barrel. The examiner disagrees and maintains that Figs. 1, 2, 4-6, 13, and 14 of Galli show a sleeve mounted at the first end of the barrel. In this regard "mounted at" is construed as placed on. If Applicant is arguing that "mounted at" means some connection at the distal end of the barrel, then examiner points out that this arrangement is not shown in the drawings or described in the specification and would be considered new matter.

Applicant argues that Galli does not show a spring between a needle and sleeve. The claims recite a needle between a needle assembly and sleeve which is shown in Galli, Figs. 13, 14.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (703) 305-5873. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler, can be contacted at (703) 308-3552. The fax number for submitting official papers is (703) 872-9302. The fax number for submitting after final papers is (703) 872-9303.

mjh
17 May 2003

**MICHAEL J. HAYES
PRIMARY EXAMINER**